

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Malik

Serial No.: 09/750,138

Filed: December 29, 2000

Confirmation No.: 6782

Group Art Unit: 2143

Examiner: Neurauter, George C.

Docket No.: 190252-1720

**For: Method and Apparatus for Managing and Compacting Electronic Mail
Messages**

APPEAL BRIEF UNDER 37 C.F.R. §41.31

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the decision of Examiner Chou, Group Art Unit 2143, mailed November 13, 2007, rejecting all claims 1-3, 6-8, 15, and 21-45 in the present application and making the rejection FINAL.

I. REAL PARTY IN INTEREST

The real party in interest of the instant application is AT&T Delaware Intellectual Property, Inc., having its principal place of business at 824 Market Street, Suite 425, Wilmington, Delaware 19801. BellSouth Intellectual Property Corporation, the assignee of record, changed its name to AT&T Delaware Intellectual Property, Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

The Office Action of January 26, 2007 rejects claims 1-3, 6-8, 15, and 21-45 under 35 U.S.C. 102(e) as allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768), all of which currently stand rejected. Claims 4-5, 9-14, and 16-20 stand canceled.

IV. STATUS OF AMENDMENTS

Claims 1-3, 15, 21-23, 30-36, and 42 have been amended during prosecution. A copy of the current claims is attached hereto in the Claims – Appendix. Amendments to claims 1, 15, and 21; new claims 30-42; and cancellation of claims 4-5, 9-14, 16-20, 24-25, and 29 made in response to the Office Action mailed April 19, 2004 were entered. Amendments to claims 1-3, 21, 22, 34-36, and 42 made in response to the Office Action mailed January 26, 2005 were entered. Amendments to claims 1-3, 21, 22, 34-36, and 42 made in response to the Office Action mailed May 23, 2005 were entered. Amendments to

claims 1, 21, and 35 and new claims 43-45 made in response to the Office Action mailed April 18, 2006 were entered. Amendments to claims 1-3, 15, 21-23, 30-33, and 35 made in response to the Office Action mailed October 2, 2006 were entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 recites a method for automatically managing an electronic mail server application on a host computer, comprising: checking an electronic mail message against a predetermined criteria (See, e.g., Specification, pg 10, lines 17-20); determining whether the message has been previously compressed (See, e.g., Specification, pg 11, lines 2-6); compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed (See, e.g., Specification, pg 10, lines 1-3); and storing the compacted electronic mail message (See, e.g., Specification, pg 9, lines 2-4).

Claim 21 recites a method for managing a user's electronic mailbox on a computer, comprising: performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria (See, e.g., Specification, pg 12, lines 14-16); determining if the electronic mail message has been previously compressed (See, e.g., Specification, pg 10, lines 1-3); compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied (See, e.g., Specification, pg 10, lines 1-3), wherein compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns; and storing the compressed electronic mail message (See,

e.g., Specification, pg 9, lines 2-4).

Claim 35 recites a computer readable medium with logic embedded therein for executing on a computer for managing a electronic mailbox on a computer comprising: logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria (See, e.g., Specification, pg 12, lines 14-16); logic configured to determine if the message has been previously compressed (See, e.g., Specification, pg 10, lines 1-3); logic configured to, if the predetermined criteria is satisfied, compress the electronic mail message by finding repeated patterns in the message and encoding those patterns (See, e.g., Specification, pg 10, lines 1-3); and logic for storing the compressed electronic mail message (See, e.g., Specification, pg 9, lines 2-4).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-3, 6-8, 15, and 21-45 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768).

VII. ARGUMENT

Discussion Relevant to All Claims – Rejections Under 35 U.S.C. §102(e)

A. Claims 1-3, 6-8, 15, and 43

The Office Action rejects claims 1-3, 6-8, 15, and 43 under 35 U.S.C. §102(e) as allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1, recites:

1. A method for automatically managing an electronic mail server application on a host computer, comprising:
 checking an electronic mail message against a predetermined criteria;
 determining whether the message has been previously compressed;
 compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed; and
 storing the compacted electronic mail message.
(Emphasis added).

Applicant respectfully submits that claim 1 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Shaffer* does not disclose, teach, or suggest at least **determining whether the message has been previously compressed**. Even if, assuming for the sake of argument, *Shaffer* discloses the compression of files, *Shaffer* fails to determine whether the file was previously compressed. The Final Office Action asserts that “a file may have an infinite number of varying degrees of compression.” *See Office Action*, pg. 3. Applicant respectfully submits that there may be many ways to determine whether a file has been previously compressed, including determining if the file is a “zipped file” as disclosed on page 11 of the Specification. However, *Schaffer* fails to disclose any method of determining if the file has been previously compressed, regardless of any method used to compress the file. A message size, by itself, without knowledge of a previous message size, does not indicate whether a file has been compressed. Applicant respectfully submits that *Shaffer* does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 1, as amended, is allowable over the cited references of record, dependent claims 2-3, 6-8, 15, and 43 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6-8, 15, and 43 contain all the features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-3, 6-8, 15, and 43 are patentable over

Shaffer, the rejection to claims 2-3, 6-8, 15, and 43 should be withdrawn and the claims allowed.

B. Claims 21-23, 26-28, 30-34, and 44

The Office Action rejects claims 21-23, 26-28, 30-34, and 44 under 35 U.S.C. §102(e) as allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 21 recites:

21. A method for managing a user's electronic mailbox on a computer, comprising:
performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria;
determining if the electronic mail message has been previously compressed;
compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns; and
storing the compressed electronic mail message.

(Emphasis added).

Applicant respectfully submits that claim 21 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 21 is allowable for at least the reason that *Shaffer* does not disclose, teach, or suggest at least **determining if the**

electronic mail message has been previously compressed. Even if, assuming for the sake of argument, *Shaffer* discloses the compression of files, *Shaffer* fails to determine whether the file was previously compressed. The Final Office Action asserts that "a file may have an infinite number of varying degrees of compression." See *Office Action*, pg. 3. Applicant respectfully submits that there may be many ways to determine whether a file has been previously compressed, including determining if the file is a "zipped file" as disclosed on page 11 of the Specification. However, *Schaffer* fails to disclose any method of determining if the file has been previously compressed, regardless of any method used to compress the file. A message size, by itself, without knowledge of a previous message size, does not indicate whether a file has been compressed. Applicant respectfully submits that *Shaffer* does not anticipate independent claim 21, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 21 is allowable over the cited references of record, dependent claims 22-23, 26-28, 30-34, and 44 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-23, 26-28, 30-34, and 44 contain all the features of independent claim 21. Therefore, since dependent claims 22-23, 26-28, 30-34, and 44 are patentable over *Shaffer*, the rejection to claims 22-23, 26-28, 30-34, and 44 should be withdrawn and the claims allowed.

C. Claims 35-42 and 45

The Office Action rejects claims 35-42 and 45 under 35 U.S.C. §102(e) as

allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 35 recites:

35. A computer readable medium with logic embedded therein for executing on a computer for managing a electronic mailbox on a computer comprising:
logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria;
logic configured to determine if the message has been previously compressed;
logic configured to, if the predetermined criteria is satisfied, compress the electronic mail message by finding repeated patterns in the message and encoding those patterns; and
logic for storing the compressed electronic mail message.
(Emphasis added).

Applicant respectfully submits that claim 35 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 35 is allowable for at least the reason that *Shaffer* does not disclose, teach, or suggest at least ***logic configured to determine if the message has been previously compressed.*** Even if, assuming for the sake of argument, *Shaffer* discloses the compression of files, *Shaffer* fails to determine whether the file was previously compressed. The Final Office Action asserts that "a file may have an infinite number of varying degrees of compression." See *Office Action*, pg. 3. Applicant respectfully submits that there may be many ways to determine whether a file has been previously compressed, including determining if the

file is a "zipped file" as disclosed on page 11 of the Specification. However, *Schaffer* fails to disclose any method of determining if the file has been previously compressed, regardless of any method used to compress the file. A message size, by itself, without knowledge of a previous message size, does not indicate whether a file has been compressed. Applicant respectfully submits that *Shaffer* does not anticipate independent claim 35, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 35 is allowable over the cited references of record, dependent claims 36-42 and 45 (which depend from independent claim 35) are allowable as a matter of law for at least the reason that dependent claims 36-42 and 45 contain all the features of independent claim 35. Therefore, since dependent claims 36-42 and 45 are patentable over *Shaffer*, the rejection to claims 36-42 and 45 should be withdrawn and the claims allowed.

CONCLUSION

Based upon the foregoing discussion, Applicant respectfully requests that the Examiner's final rejection of claims 1-3, 6-8, 15, and 21-45 be overruled by the Board, and that the application be allowed to issue as a patent with all pending claims.

The PTO is authorized to charge the \$510 fee for this Appeal Brief to the credit account identified in the accompanying credit card authorization form. No additional fee is believed to be due in connection with this appeal. If, however, any additional fee is deemed to be payable, you are hereby authorized to charge any such fee to deposit account 20-0778.

Respectfully submitted,

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VIII. CLAIMS - APPENDIX

1. (Previously Presented) A method for automatically managing an electronic mail server application on a host computer, comprising:

checking an electronic mail message against a predetermined criteria;
determining whether the message has been previously compressed;
compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed; and
storing the compacted electronic mail message.

2. (Previously Presented) The method of claim 1, wherein the checking is performed when the electronic mail message is received by the electronic mail server application.

3. (Previously Presented) The method of claim 1, wherein the checking is performed periodically on the host computer.

Claims 4.-5. (Canceled).

6. (Original) The method of claim 1, wherein the predetermined criteria comprises a total message size.

7. (Original) The method of claim 1, wherein the predetermined criteria comprises an attachment size.

8. (Original) The method of claim 1, wherein the predetermined criteria comprises an attachment type.

Claims 9.-14. (Canceled).

15. (Previously Presented) The method of claim 1, further comprising compressing the attachment.

Claims 16.-20. (Canceled).

21. (Previously Presented) A method for managing a user's electronic mailbox on a computer, comprising:

performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria;

determining if the electronic mail message has been previously compressed;

compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns; and

storing the compressed electronic mail message.

22. (Previously Presented) The method of claim 21, wherein the checking is performed when the electronic mail message is received by the electronic mailbox.

23. (Previously Presented) The method of claim 21, wherein the checking is performed upon request by the user.

Claims 24.-25. (Canceled).

26. (Original) The method of claim 21, wherein the predetermined criteria comprises a total message size.

27. (Original) The method of claim 21, wherein the predetermined criteria comprises an attachment size.
28. (Original) The method of claim 21, wherein the predetermined criteria comprises an attachment type.
29. (Canceled).
30. (Previously Presented) The method of claim 21, wherein the location of the searching of the message is on a server.
31. (Previously Presented) The method of claim 21, wherein the location of the searching of the message is on a client.
32. (Previously Presented) The method of claim 21, wherein the location of the searching of the message is configured by a user.
33. (Previously Presented) The method of claim 21, wherein the searching is performed periodically on the computer.
34. (Previously Presented) The method of claim 21, wherein the electronic mail message is compressed into a zipped file.

35. (Previously Presented) A computer readable medium with logic embedded therein for executing on a computer for managing a electronic mailbox on a computer comprising:

logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria;

logic configured to determine if the message has been previously compressed;

logic configured to, if the predetermined criteria is satisfied, compress the electronic mail message by finding repeated patterns in the message and encoding those patterns; and

logic for storing the compressed electronic mail message.

36. (Previously Presented) The computer readable medium of claim 35, further comprising logic configured to screen when the electronic mail message is received by the electronic mailbox.

37. (Previously Presented) The computer readable medium of claim 35, further comprising logic configured to screen upon request by the user.

38. (Previously Presented) The computer readable medium of claim 35, further comprising logic configured to screen periodically.

39. (Previously Presented) The computer readable medium of claim 35, wherein the

predetermined criteria comprises a total message size.

40. (Previously Presented) The computer readable medium of claim 35, wherein the predetermined criteria comprises an attachment size.

41. (Previously Presented) The computer readable medium of claim 35, wherein the predetermined criteria comprises an attachment type.

42. (Previously Presented) The computer readable medium of claim 35, wherein the electronic mail message is compressed into a zipped file.

43. (Previously Presented) The method of claim 1, further comprising decompacting the compacted electronic mail message for retrieval.

44. (Previously Presented) The method of claim 21, further comprising decompressing the compressed electronic mail message for retrieval.

45. (Previously Presented) The computer readable medium of claim 35, further comprising logic for decompressing the compressed electronic mail message for retrieval.

IX. EVIDENCE - APPENDIX

None.

IX. RELATED PROCEEDINGS - APPENDIX

None.